

Exhibit A



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,728	07/29/2003	5946669	3250.010001	3043

7590 08/01/2005

Finnegan Henderson Farabow
Garrett & Dunner LLP
1300 I Street NW
Washington, DC 20005

EXAMINER

RECEIVED

ART UNIT PAPER NUMBER

AUG 04 2005

DATE MAILED: 08/01/2005

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP

Please find below and/or attached an Office communication concerning this application or proceeding.

Best Available Copy

Office Action in Ex Parte ReexaminationControl No.
90/006,728Patent Under Reexamination
5946669Examiner
Stefano KarmisArt Unit
3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a ☒ Responsive to the communication(s) filed on 11 July 2005. b ☒ This action is made FINAL.
c ☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire ^(Two)2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892. 3. ☐ Interview Summary, PTO-474.
2. ☐ Information Disclosure Statement, PTO-1449. 4. ☐ _____

Part II SUMMARY OF ACTION

- 1a. ☒ Claims 1-48 are subject to reexamination.
1b. ☐ Claims _____ are not subject to reexamination.
2. ☐ Claims _____ have been canceled in the present reexamination proceeding.
3. ☐ Claims _____ are patentable and/or confirmed.
4. ☒ Claims 1-48 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ The drawings, filed on _____ are acceptable.
7. ☐ The proposed drawing correction, filed on _____ has been (7a) ☐ approved (7b) ☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some* c) ☐ None of the certified copies have
 1 ☐ been received.
 2 ☐ not been received.
 3 ☐ been filed in Application No. _____.
 4 ☐ been filed in reexamination Control No. _____.
 5 ☐ been received by the International Bureau in PCT application No. _____.
 * See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. ☐ Other: _____

cc: Requester (if third party requester)

DETAILED ACTION

1. The following communication is in response to Patent owner's amendment, filed 11 July 2005.

Status of Claims

2. Claims 1, 8, 10, 17, 19, 21, 32, 33, 34, 36, 47 and 48 are currently amended. Claims 1-48 are pending.

Response to Amendment

3. The declaration filed on 11 July 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Remington et al. (U.S. Patent 6,070,150) reference.
4. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Remington et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Mr. Polk relied upon Exhibit 1 and Exhibit 2 to show conception. Specifically, Mr. Polk references "Formatted 521 Records" in Exhibit 2 to account for payment information including debit transactions saying that "one of

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ordinary skill in this field would have known at the time of this invention that 521 records allow for payments using either credit transactions or debit transactions.” However, there is no evidence to support the claim that one of ordinary skill in the art would know that Formatted 521 records allow for debit and credit transactions. Therefore, without proper evidence to support the assertion, conception has not been established.

Further, there is no support in Exhibit 2 that the accumulator agency transmits the disbursement to the state. The Exhibit appears to teach that information only flows from the state to the accumulator agency, and not vice-versa. Therefore conception has not been established and the 1.131 declaration is ineffective.

5. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Remington et al. reference to either a constructive reduction to practice or an actual reduction to practice. The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958). In the submitted declaration, there are periods of time where diligence is lacking. Specifically, there is no statement regarding time periods from June 27 when Mr. Lavenue left a message to discuss the invention with Mr. Polk and July 1 when Mr. Polk began travel for other work obligations. Further, there is inactivity after Mr. Polk returned from travel and after the July 4 holiday weekend: Mr. Polk recorded on July 8 to return the call from June 27 as a “to-be-done-today” task, however the call was not returned until July 14, with unexplained inactivity between. Continuing, there is lack of affirmative acts or acceptable excuses between July 21 and

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August 5 as well as August 9, after Mr. Polk was in New York, through August 13 when Mr. Polk again addressed the invention. Therefore diligence is lacking for at least the reasons stated above. The entire period during which diligence is required must be accounted for and a 2-day period lacking activity has been held to be fatal when accounting for the period in which diligence is required. *In re Mulder*, 716 F. 2d 1542, 1545, 219 USPQ 189, 198 (Fed. Cir. 1983)(37 CFR 1.131 issue). Therefore diligence is lacking and the declaration under 37 C.F.R. 1.131 is ineffective.

Response to Arguments

6. Patent owner's arguments, see section B of Remarks, filed 11 July 2005, with respect to the 35 U.S.C. 102 rejection of claims 1-48 over Washington State Electronic Funds Transfer Project, Final Report ("Washington State Reference") have been fully considered and are persuasive. The amendment submitted by the Applicant was sufficient to distinguish claims 1-48 from the Washington State Reference.

7. Patent owner's arguments, see section C of Remarks, filed 11 July 2005 with respect to the 35 U.S.C. 103 rejection of claims 1-48 over Washington State Electronic Funds Transfer Project, Final Report ("Washington State Reference") in view of Remington et al. have been fully considered but they are not persuasive. Specifically, patent owner relied upon a declaration under 37 C.F.R. 1.131 which is considered ineffective as stated above. No other arguments regarding the teachings of Remington et al. were submitted. Therefore, the rejections of claims

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1-48 over Washing State Reference in view of Remington et al. stand rejected as stated in paragraph 5 of the previous office action, mailed 11 May 2005.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washington State Electronic Funds Transfer Project, Final Report ("Washington State Reference") in view of Remington et al. U.S. Patent 6,070,150.

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Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washington State Electronic Funds Transfer Project, Final Report ("Washington State Reference") in view of Remington et al. U.S. Patent 6,070,150 as stated in paragraph 5 of the previous office action. Claim 1 has been amended to include that the accumulator agency, the bank and the state are separate entities. As stated in the previous office action, Remington et al. discloses an accumulator agency (element 56) (Figure 2; column 3, lines 18-23). It would have been obvious to one with ordinary skill in the art to modify the payment transfer teachings of the Washington State Reference and include an accumulator agency being a function performed outside and apart of the claimed state or bank because Remington et al. teaches this as an option for payment transfers (column 4, lines 3-15).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,946,669 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly appraise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

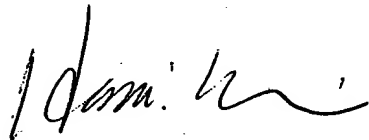
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
22 July 2005



HANI M. KAZIMI
PRIMARY EXAMINER
Conferee
Hani Kazimi
Primary Examiner
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